

REMARKS / ARGUMENTS

Reconsideration of the application as amended is respectfully requested.

Before entry of the present amendment, Claims 1-10 were pending. Claim 6 has been canceled, without prejudice. Claims 7-10 were rejected as being dependant on a rejected base claim, but were considered allowable if rewritten in an independent form. Claim 7 has been so amended, including all the limitations of any intervening claims. Claim 10 has been amended to be dependant on claim 7. Claim 8 is also dependant on Claim 7, and claim 9 dependant on claim 8. Therefore, claims 7-10 should be in condition for allowance as amended.

Claims 1-5 were rejected under 35 U.S.C. 103(a) as being unpatentable over Asher, in view of Wike. However, Asher discloses and claims a method for determining whether items are removed from a refrigerator and, based solely on incremental weight changes due to removal of individual items, determines the nature of the item removed. Nowhere is there disclosed or anticipated the recording of an image of each individual element of said set. Further, it is not anticipated that the contents be returned to the refrigerator at all, such that there is no necessity for verifying set completeness. Also, Wike discloses and claims a cash register-checkout method wherein the only anticipated use of "the video camera 94a is operated so as to capture a video image of the user (e.g. the customer or the checkout clerk) who is operating the checkout system 10". Col 23, lines 2-4. This is for security only, to be able to identify the user of the system should any theft be detected. This is a drastically different anticipated use than for "recording of an image of each individual element" for comparison to "an electronic database for future recall", Claim 3, from image data and compared from current capture versus electronic database

recording, claim 5.

In undertaking a determination of whether a reference, or a combination of references, renders a claim(s) obvious under 35 U.S.C. § 103(a), the examiner must show that the reference or combination of references teach or suggest every element of the claim(s) in question. MPEP § 706.02(j). In regard to the rejection of claims 1-5 under 35 U.S.C. § 103(a), based upon the above arguments, it is felt that the differences between the present invention and all of these references are such that rejection based upon 35 U.S.C. § 103(a), in addition to any other art, relevant or not, is also inappropriate. However, by way of additional argument applicant wishes to point out that it is well established at law that for a proper *prima facie* rejection of a claimed invention based upon obviousness under 35 U.S.C. § 103(a), the cited references must teach every element of the claimed invention. Further, if a combination is cited in support of a rejection, there must be some affirmative teaching in the prior art to make the proposed combination. See Orthopedic Equipment Company, Inc. et al. v. United States, 217 USPQ 193, 199 (Fed. Cir. 1983), wherein the Federal Circuit decreed, "Monday Morning Quarter Backing is quite improper when resolving the question of obviousness." Also, when determining the scope of teaching of a prior art reference, the Federal Circuit has declared:

"[t]he mere fact that the prior art could be so modified should not have made the modification obvious unless the prior art suggested the desirability of the modification." (Emphasis added). In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

There is no suggestion as to the desirability of any modification of the references to

describe the present invention. An analysis of the disclosures within the cited references fails to cite every element of the claimed invention. When the prior art references require a selective combination to render obvious a subsequent claimed invention, there must be some reason for the selected combination other than the hindsight obtained from the claimed invention itself. Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 227 USPQ 543 (Fed. Cir. 1985). There is nothing in the prior art or the Examiners arguments that would suggest the desirability or obviousness of making a method and device for identifying the image and weight of a surgical tool for purposes of comparing completeness of a surgical set post-operation. Uniroyal, Inc. v. Rudkki-Wiley Corp., 837 F.2d 1044, 5 USPQ 2d 1432 (Fed. Cir. 1988). The examiner seems to suggest that it would be obvious for one of ordinary skill to attempt to produce the currently disclosed invention. However, there must be a reason or suggestion in the art for selecting the design, other than the knowledge learned from the present disclosure. In re Dow Chemical Co., 837 F.2d 469, 5 USPQ 2d 1529 (Fed. Cir. 1988); see also In re O'Farrell, 853 F.2d 894, 7 USPQ 2d 1673 (Fed. Cir. 1988).

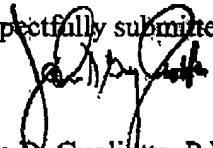
To summarize, it appears that only in hindsight does it appear obvious to one of ordinary skill in the pertinent art to combine the present claimed and disclosed combination of elements. To reject the present application as a combination of old elements leads to an improper analysis of the claimed invention by its parts, and instead of by its whole as required by statute. Custom Accessories Inc. v. Jeffery-Allan Industries, Inc., 807 F.2d 955, 1 USPQ 2d 1197 (Fed. Cir. 1986); In re Wright, 848 F.2d 1216, 6 USPQ 2d 1959 (Fed. Cir. 1988).

Therefore, in view of foregoing amendments and clarifications, the applicant submits

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that allowance of the present application and all remaining claims, as amended, is in order and a formal Notice of Allowance is respectfully requested at the earliest possible date.

Respectfully submitted,


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